UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,563	07/16/2001	Hiroshi Kobata	11365-043002	2322

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EXAMINER
ABDI, KAMBIZ

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>16 September 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-21 and 52-55</u> is/are pending in the application.

    4a) Of the above claim(s) <u>22-51 and 56-62</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-21 and 52-55</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>16 July 2001</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-21 and 52-55 have been examined and are pending.

Drawings

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application

because the filed drawing pages are not up to the office standards under 37 CFR 1.121. The drawings

are of sufficient detail for examination, however, replacement of current informal drawings with formal

drawings at the time of allowance is required. Applicant is advised to employ the services of a competent

patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new

drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the

application. The requirement for corrected drawings will not be held in abeyance.

Specification

2.   The specification has not been checked to the necessary extent needed to determine the

presence of all possible minor errors (i.e. typo, miss labeling). Applicant is encouraged to review the

specification in details and correct any errors or misspelling of which applicant may become aware in the

specification.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter, which the applicant regards as his invention.

4.   Claims 1-3 and 15-21 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for

omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.

The omitted steps are: the claim recites "[c]ause the encrypted executable file to run..." Such running of

encrypted file has not been provided as how an encrypted file be executed as it has been claimed in the

claim. Examiner will consider the encrypted file first is decrypted and then executed or run.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for

the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6.   Claims 1-21 and 52-55 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent

No. 7,036011 to Tom Grimes et al. or by U.S. Patent application Publication No. 2005/0149450 A1 to

Mark J. Stefik et al.

7.   AS per claims 1, 21and 52, Grimes and Stefik clearly discloses a method for managing digital

rights of software on a computer system, comprising:

- encrypting at least a portion of an executable file to generate an encrypted executable file (See

  Grimes column 8, lines 51-55) and (See Stefik paragraphs [0017]-[0021], [0089], [0107], [0144]-

  [0145]);

- writing the encrypted executable file to a host location on the computer system during installation

  of software including the encrypted executable file (See Grimes column 8, lines 51-55) and (See

  Stefik paragraphs [0017]-[0021], [0089], [0107], [0144]-[0145]); and

- providing a loader for the encrypted executable file wherein the loader is operable to authenticate

  the encrypted executable file and cause the encrypted executable file to run on the computer

  system (See Grimes abstract, figures 3A and 3B, column 7, line 30-column 9, line 60)) and (See

  Stefik figures 1, 16-19, paragraphs [0016][0021], [0107], [0129], [0133], [0146]).

8.   As per claim 221and 52, Grimes and Stefik clearly discloses the method of claim 1 wherein the

portion of the executable file comprises initial variables of the executable file (See Grimes abstract,

figures 3A and 3B, column 7, line 30-column 9, line 60) and (See Stefik figures 1, 16-19, paragraphs

[0017]-[0021], [0089], [0107], [0129], [0133], [0144]-[0146])..

9.   As per claim 3, Grimes and Stefik clearly discloses the method of claim 1 further comprising

executing the encrypted executable file (See Grimes abstract, figures 3A and 3B, column 7, line 30-

column 9, line 60) and (See Stefik figures 1, 16-19, paragraphs [0017]-[0021], [0089], [0107], [0129],

[0133], [0144]-[0146]).

10.   As per claim 4, Grimes and Stefik clearly discloses the method of claim 3 wherein executing the

encrypted executable file comprises: authenticating the encrypted executable file; writing the encrypted

executable file to a memory location of the computer system; decrypting the portion of the encrypted

executable file; and running the decrypted portion of the encrypted executable file (See Grimes abstract,

figures 3A and 3B, column 7, line 30-column 9, line 60) and (See Stefik figures 1, 16-19, paragraphs

[0017]-[0021], [0089], [0107], [0129], [0133], [0144]-[0146]).

11.   As per claim 5, Grimes and Stefik clearly discloses the method of claim 4 wherein authenticating

the encrypted executable file comprises confirming that rights in a rights document are satisfied (See

Grimes abstract, figures 3A and 3B, column 7, line 30-column 9, line 60) and (See Stefik figures 1, 16-19,

paragraphs [0017]-[0021], [0089], [0107], [0129], [0133], [0144]-[0146]).

12.   As per claim 6, Grimes and Stefik clearly discloses the method of claim 5 wherein the rights

document is appended to the encrypted executable file (See Grimes abstract, figures 3A and 3B, column

7, line 30-column 9, line 60) and (See Stefik figures 1, 16-19, paragraphs [0017]-[0021], [0089], [0107],

[0129], [0133], [0144]-[0146]).

13.   As per claim 7, Grimes and Stefik clearly discloses the method of claim 5 wherein confirming that

rights in a rights document have been satisfied comprises determining whether the computer system is an

authorized computer system on which the software is authorized to be installed (See Grimes abstract,

figures 3A and 3B, column 7, line 30-column 9, line 60) and (See Stefik figures 1, 16-19, paragraphs

[0017]-[0021], [0089], [0107], [0129], [0133], [0144]-[0146]).

14.   As per claim 8. The method of claim 5 wherein the rights document is an extensible markup

language (XML) file (See Grimes abstract, figures 3A and 3B, column 7, line 30-column 9, line 60) and

(See Stefik figures 1, 16-19, paragraphs [0017]-[0021], [0089], [0107], [0129], [0133], [0144]-[0146],

[0547]).

15.   As per claim 9, Grimes and Stefik clearly discloses the method of claim 4 wherein the

authenticating, writing and decrypting are performed by the loader (See Grimes abstract, figures 3A and

3B, column 7, line 30-column 9, line 60) and (See Stefik figures 1, 16-19, paragraphs [0017]-[0021],

[0089], [0107], [0129], [0133], [0144]-[0146]).

16.   As per claim 10, Grimes and Stefik clearly discloses the method of claim 4 wherein authenticating

the encrypted executable file comprises determining whether the encrypted executable file may be

executed on the computer system (See Grimes abstract, figures 3A and 3B, column 7, line 30-column 9,

line 60) and (See Stefik figures 1, 16-19, paragraphs [0017]-[0021], [0089], [0107], [0129], [0133], [0144]-

[0146]).

17.   As per claim 11, Grimes and Stefik clearly discloses the method of claim 4 wherein authenticating

the encrypted executable file comprises accessing a central rights database via a communication

pathway associated with the computer system (See Grimes abstract, figures 3A and 3B, column 7, line

30-column 9, line 60) and (See Stefik figures 1, 16-19, paragraphs [0017]-[0021], [0089], [0107], [0129], [0133], [0144]-[0146]).

18.   As per claim 12, Grimes and Stefik clearly discloses the method of claim 11 further comprising managing the central rights database via a remotely located server (See Grimes abstract, figures 3A and 3B, column 7, line 30-column 9, line 60) and (See Stefik figures 1, 16-19, paragraphs [0017]-[0021], [0089], [0107], [0129], [0133], [0144]-[0146]).

19.   As per claim 13, Grimes and Stefik clearly discloses the method of claim 12 wherein managing the central rights database comprises modifying usage rights of the software (See Grimes abstract, figures 3A and 3B, column 7, line 30-column 9, line 60) and (See Stefik figures 1, 16-19, paragraphs [0017]-[0021], [0089], [0107], [0129], [0133], [0144]-[0146]).

20.   As per claim 14, Grimes and Stefik clearly discloses the e method of claim 11 wherein the communication pathway includes an Internet connection (See Grimes abstract, figures 3A and 3B, column 7, line 30-column 9, line 60) and (See Stefik figures 1, 16-19, paragraphs [0017]-[0021], [0089], [0107], [0129], [0133], [0144]-[0146]).

21.   As per claim 15, Grimes and Stefik clearly discloses the method of claim 1 further comprising tracking usage of the software (See Grimes abstract, figures 3A and 3B, column 7, line 30-column 9, line 60) and (See Stefik figures 1, 16-19, paragraphs [0017]-[0021], [0089], [0107], [0129], [0133], [0144]-[0146]).

22.   As per claim 16, Grimes and Stefik clearly discloses the method of claim 15 wherein tracking usage of the software comprises gathering information about the usage of the software via a communication pathway associated with the computer system (See Grimes abstract, figures 3A and 3B,

column 7, line 30-column 9, line 60) and (See Stefik figures 1, 16-19, paragraphs [0017]-[0021], [0089], [0107], [0129], [0133], [0144]-[0146]).

23.   As per claim 17, Grimes and Stefik clearly discloses the e method of claim 1 wherein the executable file can be executed via only the loader (See Grimes abstract, figures 3A and 3B, column 7, line 30-column 9, line 60) and (See Stefik figures 1, 16-19, paragraphs [0017]-[0021], [0089], [0107], [0129], [0133], [0144]-[0146]).

24.   As per claim 18, Grimes and Stefik clearly discloses the method of claim 1 wherein the loader comprises software code specifically written to authenticate, load, decrypt and execute the encrypted executable file in a manner transparent to an end-user.

25.   As per claim 19, Grimes and Stefik clearly discloses the method of claim 1 wherein the executable file comprises an executable binary file (See Grimes abstract, figures 3A and 3B, column 7, line 30-column 9, line 60) and (See Stefik figures 1, 16-19, paragraphs [0017]-[0021], [0089], [0107], [0129], [0133], [0144]-[0146]).

26.   As per claim 20, Grimes and Stefik clearly discloses the method of claim 1 wherein the executable file comprises a header portion, a code portion and a data portion, and wherein encrypting at least a portion of an executable file comprises encrypting at least one of the code portion and the data portion (See Grimes abstract, figures 3A and 3B, column 7, line 30-column 9, line 60) and (See Stefik figures 1, 16-19, paragraphs [0017]-[0021], [0089], [0107], [0129], [0133], [0144]-[0146]).

27.   As per claim 53, Grimes and Stefik clearly discloses the method of claim 52 further comprising tracking a number of times a particular copy of the software is installed (See Grimes abstract, figures 3A

and 3B, column 7, line 30-column 9, line 60) and (See Stefik figures 1, 16-19, paragraphs [0017]-[0021], [0089], [0107], [0129], [0133], [0144]-[0146]).

28.   As per claim 54, Grimes and Stefik clearly discloses the method of claim 52 further comprising logging an identity of the computer system onto which a particular copy of the software is installed or is attempted to be installed (See Grimes abstract, figures 3A and 3B, column 7, line 30-column 9, line 60) and (See Stefik figures 1, 16-19, paragraphs [0017]-[0021], [0089], [0107], [0129], [0133], [0144]-[0146]).

29.   As per claim 55, Grimes and Stefik clearly discloses the method of claim 52 wherein the digital rights database includes information about installation rights of individual copies of the software (See Grimes abstract, figures 3A and 3B, column 7, line 30-column 9, line 60) and (See Stefik figures 1, 16-19, paragraphs [0017]-[0021], [0089], [0107], [0129], [0133], [0144]-[0146]).

30.   Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. Applicant should consider the entire prior art as applicable as to the limitations of the claims. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Patnet Application Publication No. US 20030163431 A1 to Karl L. Ginter et al., Systems and methods for secure transaction management and electronic rights protection

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to **Kambiz Abdi** whose telephone number is **(571) 272-6702**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **(571) 272-6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see

http://portal.uspto.gov/external/portal/pair

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(571) 273-8300 [Official communications; including After Final communications labeled "Box AF"]

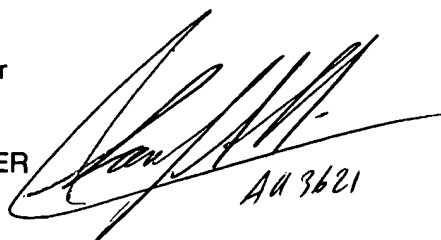**(571) 273-6702** [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Examiner in the

Knox Building, 50 Dulany St. Alexandria, VA.

Kambiz Abdi
Primary Examiner

KAMBIZ ABDI
PRIMARY EXAMINER

May 12, 2006